

REMARKS

I. Introduction

Claims 1-29 are pending in the present application. In the Office Action dated June 22, 2007, the Examiner rejected claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication US2003/0023536 A1 ("Hollerman et al.") and further in view of Forward-Start Options (Forward).

II. Summary Of Discussion With Examiner

Jordan Newmark, a representative of the assignee, held a telephone discussion with the Examiner in July 2007. The Examiner is thanked for the courtesy extended during the conversation. The common ownership of the present application and cited U.S. Patent Publication US2003/0023536 A1 were discussed. At the conclusion of the discussion, the Examiner indicated that she would contact Mr. Newmark to follow-up with a preferred course of action in addressing the issue of common ownership. Subsequently, the Examiner, in a voicemail to Mr. Newmark, indicated that an affirmative statement establishing common ownership of the present application and cited U.S. Patent Publication US2003/0023536 A1 would suffice.

III. Statement Establishing Common Ownership In View Of Rejection Under 35 U.S.C. §103(a) based on Hollerman et al.

In the Official Action, the Examiner has rejected claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over Hollerman et al., in view of Forward.

In response, and to overcome the Examiner's rejections in connection with the cited Hollerman et al. reference, Applicants affirmatively state herewith that the present application, Application Serial No. 10/017,040, and U.S. Patent Publication US2003/0023536 A1 were, at the time the invention of Application Serial No.

10/017,040 was made, owned by Chicago Board Options Exchange, Incorporated. As the subject matter of Hollerman et al. which would otherwise be prior art to the claimed invention and the later claimed invention was commonly owned at the time the invention was made (and still is), Hollerman et al. is disqualified as prior art under 35 U.S.C. 103(c). See MPEP §§ 706.02(I) and 706.02(I)(1).

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the Examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. See MPEP § 706.02(I)(2).

Moreover, Applicants submit, *in addition to* the abovementioned statement regarding common ownership, the following references to assignments recorded in the U.S. Patent and Trademark Office in accordance with 37 CFR Part 3 which convey the entire rights in the applications to the same organization (Chicago Board Options Exchange, Incorporated) and which further provide objective evidence that the present application, Application Serial No. 10/017,040, and U.S. Patent Publication US2003/0023536 A1 were, at the time the invention of Application Serial No. 10/017,040 was made, owned by Chicago Board Options Exchange, Incorporated:

- Assignment of U.S. Patent Publication US2003/0023536 A1, Reel/Frame 012023/0917, recorded on July 25, 2001, to Chicago Board Options Exchange, Incorporated; and

- Assignment of U.S. Patent Application Serial No. 10/017,040, Reel/Frame 012748/0939, recorded on March 25, 2002, to Chicago Board Options Exchange, Incorporated.

Thus, Applicants respectfully request reconsideration and withdrawal of the rejections under § 103 as to these claims.

IV. Conclusion

In view of the foregoing remarks, Applicants submit that the pending claims are in condition for allowance. Reconsideration is therefore respectfully requested, as is an early Notice of Allowance. If there are any questions concerning this Response, the Examiner is invited to contact one of the undersigned attorneys to discuss the matters in an effort to successfully complete the prosecution of this application.

Respectfully submitted,

By: 

Date: September 4, 2007

James F. Goedken
Reg. No. 44,715
P.O. Box 1135
Chicago, Illinois 60690-1135

Jordan A. Newmark, Reg. No. 50,904
Intellectual Property Counsel
Chicago Board Options Exchange, Incorporated
400 S. LaSalle Street
Chicago, Illinois 60605
Tel.: (312) 786-7909
Email: newmark@cboe.com